

C. REMARKS**Status of the Claims**

Claims 1, 18, and 28 are independent claims, and have been amended to further clarify the invention. Claim 12 was inadvertently cancelled in a previous amendment, and has now been reinstated as claim 41. Claims 1, 3-10, 14, 15, 18, 20-23, 25, 27, 28, 30-33, 35, and 37-41 are currently present in the Application.

Claim Rejections - Alleged Obviousness Under 35 U.S.C. § 103

Claims 1, 3, 18, 20, 27, 28, 30, and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tognazzini, U.S. Patent No. 5,790,974 (hereinafter Tognazzini), in view of Paredes, U.S. Patent No. 5,973,619 (hereinafter Paredes). Claims 4-10, 21-23, and 31-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tognazzini in view of Paredes, and further in view of Levine, U.S. Patent No. 6,076,121 (hereinafter Levine). Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tognazzini in view of Paredes, and further in view of Berman et al., U.S. Patent No. 5,995,939 (hereinafter Berman). Claims 38-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tognazzini in view of Paredes, and further in view of Felger, U.S. Patent No. 6,553,108 (hereinafter Felger). Applicants respectfully traverse the rejections.

Applicants teach and claim a method, system, and computer program product for performing various automated tasks based upon a user's travel arrangements, such as cancelling a user's mail delivery and/or changing voice mail messages. Independent claims 1, 18, and 28 have been amended to further clarify that

the automated requests corresponding to the user's travel arrangements are based on a traveler's (i.e. user's) user profile. Support for the amendments are found in Applicants' specification at, inter alia, page 1, lines 17-20; page 5, lines 10-14 and lines 18-19; page 22, lines 3-5 and lines 8-12; page 26, lines 8-10; etc.

In contrast, Tognazzini purports to teach the synchronization of calendar entries between a portable device (i.e. PDA) and a centralized calendar system (i.e. a central office) (see Abstract). Applicants' invention differs from Tognazzini in that Applicants' invention performs automated actions based upon a user's travel arrangements and user profile, whereas Tognazzini synchronizes a calendar system and checks for schedule conflicts.

Applicants agree with the Examiner's statement that Tognazzini fails to disclose sending one or more automated requests corresponding to travel arrangements from the computer system to one or more service agents, as taught and claimed by Applicants. However, Applicants respectfully disagree with the Examiner's use of Paredes to overcome the deficiencies of Tognazzini.

Paredes purports to teach an automated vehicle dispatch and payment honoring system (see Abstract). Paredes allows a user to select a transportation company, such as a taxi company, from a menu of participating companies (col. 2, 26-30). In other words, Paredes allows a user to electronically hail a taxi. Paredes does not teach or suggest "sending one or more **automated requests corresponding to the travel arrangements** from the computer system to one or more service agents, **wherein the automated requests are based on a traveler's user profile**, and

wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system," as taught and claimed by Applicants in amended, independent claims 1, 18, and 28. The portion of Paredes cited by the Examiner, i.e. col. 5, lines 48-53, merely shows that a user could electronically hail a taxi via an Internet connection or over the telephone. Although the request for a taxi is sent over a computer network, or possibly, over a telephone network, it is not an "automated request corresponding to the travel arrangements" of the user. Further, the request is not "based on a traveler's user profile." In Paredes, the user must specify every detail, including the selection of a company (col. 3, lines 61-62), the number of passengers (col. 3, 62-64), and the user's destination (col. 3, line 66 through col. 4, line 1). Only after all of this detailed information is entered and confirmed by the user will a taxi be dispatched (col. 4, lines 9-22). Paredes certainly does not teach or suggest "sending one or more **automated requests corresponding to the travel arrangements** from the computer system to one or more service agents, **wherein the automated requests are based on a traveler's user profile**," as taught and claimed by Applicants.

Applicants also disagree with the Examiner's statement that Tognazzini and Paredes are analogous art. Applicants respectfully submit that there is simply no motivation, found in the prior art, to combine the portable calendar device disclosed by Tognazzini with the vehicle dispatch system of Paredes. Instead, Applicants respectfully submit that the present Office Action improperly used Applicants' claims as "guideposts" in selecting the references and simply concluded that it would be "obvious" to combine the references. In doing so, Applicants

assert that the present Office Action used impermissible hindsight in combining Tognazzini and Paredes in order to support a rejection of Applicant's claims.

MPEP § 706 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important

in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application.

Applicants assert that the Office Action fails to satisfy the burden set forth in § 706.02(j) in support of an obviousness rejection, particularly because there is no motivation to combine the references. Tognazzini seeks to synchronize calendar entries between a portable device, such as a PDA, and a centralized calendar system. On the other hand, Paredes is concerned with a vehicle dispatch system that allows a user to electronically hail a taxi. Applicants fail to see why it would be obvious to combine the calendar synchronization system of Tognazzini with the taxi dispatch system of Paredes.

Furthermore, the Office Action fails to explain how combining the calendar synchronization system of Tognazzini with the taxi dispatch system of Paredes would result in a workable solution. While a user, possibly even a traveling user, may be interested in using both a calendar synchronization system and an electronic taxi dispatch system, these would clearly be two different systems, most likely used by the traveler at different times, in different places, and for different reasons.

For the reasons set forth above, Applicants respectfully submit that independent claims 1, 18, and 28, and the claims which depend from them, are patentable over Tognazzini in view of Paredes, and therefore respectfully request that the claims be allowed.

Notwithstanding the patentability of independent claims 1, 18, and 28, and the claims which depend from them, Applicants also briefly discuss the Office Action's citation of Levine, Berman, and Felger as follows. In general, Levine teaches a system and method to minimize the number of directory numbers (i.e. telephone numbers) that a user requires. Specifically, Levine teaches addressing and translating addresses in a network by adding a functional property code to each device a user employs (see Abstract). Levine's functional property codes are used to distinguish a device's "type," such as a telephone or a fax machine, so that more than one device can use the same directory number, and a telephone call can be directed to a particular device using the device's functional property code.

Applicants respectfully submit that there is no motivation to combine the teachings of Levine with either Tognazzini or Paredes. Levine's method of network addressing and translation is used in a network where multiple devices exist that have multiple device types. Tognazzini operates in a two-way wireless environment with two devices, each configured to communicate and synchronize with each other. Combining Levine with Tognazzini adds complexity (i.e. a functional property code), and does not provide any added feature or benefit to Tognazzini since a functional property codes does not appear to be needed in Tognazzini. Further, Applicants respectfully submit that there is no motivation to combine the teachings of Levine with Paredes as this would also add unnecessary complexity to Paredes' vehicle dispatch system. There does not appear to be any need for a functional property code in Paredes as the vehicle dispatch requests are sent over an existing network, where both the sending and receiving end of the network are configured to communicate with each other, and do not

require any specification of "device type" in order to communicate.

Berman purports to teach that service requests, such as ordering a medical test or requesting authorization for a particular procedure, are prepared and e-mailed to the sponsor system of an appropriate service provider. The request is fulfilled and the results e-mailed back (see Abstract). Berman further states that "a complete system . . . typically includes hundreds of client systems and dozens of sponsor system" (col. 2, lines 53-55), and "requires that a database of information, such as the identities of a roster of patients, be built up on the client system" (col. 3, lines 6-8).

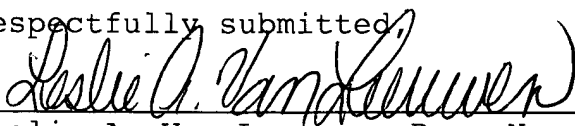
Applicants assert that there is no motivation to combine the teachings of Berman with either Tognazzini or Paredes. Berman's automated network service request and fulfillment system is targeted toward the health care industry, such as a doctor's office for ordering a specific blood test (col. 4, lines 4-9). In contrast, as discussed above, Tognazzinni uses a two-way wireless system to **synchronize calendar entries**. There is no commonality between Tognazzini and Berman and, thus, no motivation to combine. In addition, if Berman were combined with Tognazzini, the combination adds complexity (i.e. e-mail messages), and does not provide any added feature or benefit to Tognazzini because e-mail messages would not assist in the synchronization of calendar entries. Further, Applicants respectfully submit that there is no motivation to combine the teachings of Berman, which has to do with the medical industry, with the teachings of Paredes, which has to do with a vehicle dispatch service.

Felger purports to teach a method for billing a communication session between a user and a value-added service (see Abstract). The communication sessions discussed in Felger include circuit-switched calls, computer-network telephony calls, and multimedia sessions. Felger does not appear to have anything to do with scheduling travel arrangements and sending automated requests corresponding to the travel arrangements and based on a traveler's user profile, as taught and claimed by Applicants. In claims 38-40, Applicants claim a method, system, and computer program product for "increasing a user's electronic wallet balance and decreasing a user's bank account balance" as one of many possible **travel-related automatic requests**. Felger is concerned with billing for communication sessions, and not with automated requests pertaining to travel arrangements, as taught and claimed by Applicants.

Conclusion

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,
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